

## REMARKS

Claims 15-24 are pending in the application.

Based on the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections, and withdraw them.

### Obviousness-type double patenting rejection

On page 2 of the Office Action, claims 15-24 were rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-14 and 17 of copending application No. 09/684,129 in view of Warther et al. This is the only rejection remaining in this application. The rejection is respectfully traversed as being improper.

The Examiner's attention is respectfully directed to MPEP § 804.I.B-C, which governs obviousness-type double patenting rejections in the case of copending applications. These paragraphs of the MPEP state in full (with emphasis added):

#### **B. Between Copending Applications-Provisional Rejections**

Occasionally, the examiner becomes aware of two copending applications filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee that would raise an issue of double patenting if one of the applications became a patent. Where this issue can be addressed without violating the confidential status of applications ( 35 U.S.C. 122), the courts have sanctioned the practice of making applicant aware of the potential double patenting problem if one of the applications became a patent by permitting the examiner to make a "provisional" rejection on the ground of double patenting. *In re Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976); *In re Wetterau*, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

*The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than*

*one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.*

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

**C. Between One or More Applications and a Published Application - Provisional Rejections**

Double patenting may exist between a published patent application and an application filed by the same inventive entity, or by different inventive entities having a common inventor, and/or by a common assignee. Since the published application has not yet issued as a patent, the examiner is permitted to make a "provisional" rejection on the ground of double patenting. See the discussion regarding "provisional" double patenting rejection in subsection B. above.

Contrary to the instructions provided by MPEP § 804.I.B-C, the double patenting rejection in neither this application nor the copending application has been made "provisional," in spite of requests by Applicant's counsel in both cases that the requirement of a terminal disclaimer be postponed pending allowance of the claims in one of the two applications (that is, pending an indication that all other rejections are withdrawn except the obviousness-type double patenting rejection).

In the present application, all other rejections have been withdrawn. In accordance with MPEP § 804.I.B-C, it is respectfully requested that the Examiner now withdraw the obviousness-

type double patenting rejection and permit this application to issue as a patent. The Examiner may then properly make a "non-provisional" double patenting rejection in the copending application.

In view of the foregoing, it is respectfully submitted that the Examiner withdraw the present rejection and issue a Notice of Allowability for the pending claims as dictated by MPEP § 804.I.B-C.

Conclusion

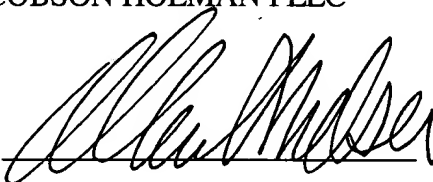
All rejections have been complied with, properly traversed, or rendered moot. Thus, it now appears that the application is in condition for allowance. Should any questions arise, the Examiner is invited to call the undersigned representative so that this case may receive an early Notice of Allowance.

Favorable consideration and allowance are earnestly solicited.

Respectfully submitted,

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